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| 09/736,414      | 12/14/2000  | Rabindranath Dutta   | AUS9000687US1       | 8776             |

35617 7590 11/24/2004

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EXAMINER

BRIER, JEFFERY A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2672

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/736,414

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Jeffery A Brier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,8-14 and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-14, and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Detailed Action***

***Response to Amendment***

1. The amendment filed on 8/27/2004 has been entered.

***Response to Arguments***

2. Applicants arguments filed on 8/27/2004 have been considered, but are deemed to not be persuasive because the 112 second paragraph issues were not completely addressed in the claim amendments.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 8-14, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1:**

Claim 1 is indefinite because at line 10 "the first and second images" and at line 12 "the first image" and "the second image" are claimed while earlier first vector graphics image and second vector graphics image is claimed. Since the specification describes both bit map image and vector graphics image then the claim should clearly claim which type of image applicant intends to be the subject of the invention. Therefore "the first and second images" at line 10 should be "the first and second vector graphics images" and at line 12 "the first image" and "the second image" should be "the first vector graphics image" and "the second vector graphics image".

Claim 13:

Claim 13 is indefinite because at line 7 "the first and second images" is claimed while earlier first vector graphics image and second vector graphics image are claimed. Since the specification describes both bit map image and vector graphics image then the claim should clearly claim which type of image applicant intends to be the subject of the invention. Therefore "the first and second images" at line 7 should be "the first and second vector graphics images".

Claims 1, 2, 8-14, and 17-19:

The editor now claimed in these claims broadly inserts instructions from the second file into the first file. The claims do not clearly state what type of files are involved in the claimed insertion. The claims do not clearly claim the editor performs the overlay in response to receiving the first vector graphics image and second vector graphics image. This distinction is critical in comparing the claims with the prior art because it was known prior to applicant's filing to manually take instructions from one file and insert them into another file. Similarly it was also known prior to applicant's filing to manually take instructions from one vector graphics image and insert them into a another vector graphics image file. Applicants specification at page 16 lines 8-14 and 21-29 and page 17 lines 11-16 discusses the three embodiments, however, only the first and third embodiments discuss the editor modifying the first vector graphics file in response to receipt of the second vector graphics file. The second embodiment discusses the editor modifying the first vector graphics file but does not state when it is modified. It may be manually down at the ad server. The third embodiment discusses

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with reference to figure 8 and step 156 modifying the first vector graphics file in response to receipt of the second vector graphics file. Page 17 line 18 to page 18 line 2 discusses the three embodiments as an editor that draws, this is different than inserting instructions from one file into another file, a first image and a second image from dissimilar executions units'/storage devices and compiles one image onto the other, this also is different than inserting instructions from one file into another file. Therefore, in view of applicants specification the claims do not clearly define what applicant is actually claiming as the invention.

Thus, the amendments to the claims come close to claiming that which was indicated as allowable, however, the claims do need further amendments.

#### ***Allowable Subject Matter***

5. Claims 1, 2, 8-14, and 17-19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action. The claims need to be amended to clearly claim the claimed editor within the computer causes the computer to overlay a portion of the first vector graphics image with the second vector graphics image by inserting instructions from the second vector graphics image file into the first vector graphics image file in response to the computer receiving the web page, the first vector graphics image and the second vector graphics image.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior of record fails to teach or suggest an editor causing a computer to

overlay a portion of the first vector graphics image with the second vector graphics image by inserting instructions from the second vector graphics image file into the first vector graphics image file in response to the computer receiving the web page, the first vector graphics image and the second vector graphics image.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is 703-305-4723. The examiner can normally be reached on M-F from 6:30 to 3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (703) 305-4713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier  
Primary Examiner  
Art Unit 2672